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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91167758
Party	Plaintiff Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A. Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT AND TRADEMARK TRIAL AND APPEAL BOARD

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a
PERNOD RICARD U.S.A.,

Opposer,

v.

LODESTAR ANSTALT,

Applicant.

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Opposition No. 91167758

**OPPOSER'S STATEMENT IN SUPPORT OF THE
ENTRY OF JUDGMENT AGAINST APPLICANT**

Opposer Austin Nichols & Co. Inc. d/b/a Pernod Ricard U.S.A. (hereinafter "Austin Nichols") hereby submits the following statement in response to the Trademark Trial and Appeal Board's ("TTAB") September 7, 2007 order directed to Applicant Lodestar Anstalt ("Applicant") to show cause why judgment should not be entered against it in view of the Board's decision sustaining the opposition in related Opposition No. 91155165 involving Austin Nichols' WILD TURKEY mark. As set forth below, the TTAB should enter judgment against Applicant's application regardless of whether it responds to the order to show cause or not.

PRIOR PROCEEDINGS

Austin Nichols is a subsidiary of Pernod Ricard S.A., one of the world's leading manufacturers and suppliers of alcoholic beverage products. Austin Nichols is the owner of WILD TURKEY, one of the most famous alcoholic beverage trademarks in United States

history. Austin Nichols has used the famous WILD TURKEY trademark in the United States since 1942, and has successfully built up goodwill of incalculable value in the WILD TURKEY mark because of its successful promotion and sale of WILD TURKEY products over the course of the past sixty years. Applicant is a company organized in Liechtenstein with no sales activities whatsoever in the United States.

The instant proceeding is Austin Nichols' second opposition to Applicant's, or a related company's, efforts to register a mark containing the term "Wild Geese" for alcoholic beverages. In June 2000, Stichting Lodestar — identified by Applicant as its "related company" in its March 30, 2006 motion to suspend the instant opposition — applied to register WILD GEESE for a variety of alcoholic beverage products (App. Ser. No. 76/074,330). The WILD GEESE application was published for opposition on January 28, 2003, and Austin Nichols filed an opposition to the registration of that mark in February 2003 (Opposition No. 91155615).

Following an oral hearing on July 5, 2005, the TTAB issued a decision, on January 17, 2006, sustaining the opposition, finding that WILD GEESE was likely to be confused with Austin Nichols' well known WILD TURKEY mark. A copy of the TTAB's January 17, 2006 decision is attached hereto as Exhibit A. The TTAB found that each of the factors considered in the likelihood of confusion analysis — strength of the WILD TURKEY marks, similarities between the parties' goods, the parties' trade channels, the classes of purchasers for the goods, and between the marks themselves (i.e., both marks showing the common first term "Wild", and "Turkey" and "Geese" having similar connotations, both being game birds) — all weighed in Austin Nichols' favor. Specifically, the TTAB found that the evidence of Austin Nichols' extensive sales and advertising, media coverage, sixty years of use of the mark, and wide

distribution of collateral merchandise, established that the WILD TURKEY was a famous mark entitled to a broad scope of protection.

Further, the TTAB found that the goods identified in connection with the WILD GEESE application — including whiskey, beer, and other alcoholic beverage products — were closely related or identical to Austin Nichols' WILD TURKEY bourbon and related products.

Moreover, the TTAB concluded that the goods would travel in the same channels of trade to the same classes of purchasers, who, the TTAB found, would not exercise great care in making their purchases.

Finally, the TTAB rejected Stichting Lodestar's argument that WILD TURKEY is a weak mark due to "numerous third-party registrations and uses of the word WILD" and "numerous registrations and uses of bird names" in connection with various alcoholic and non-alcoholic beverage products, finding that Stichting Lodestar failed to prove that the terms had "ordinary significance" in the field of alcohol beverages. Additionally, the TTAB found that Stichting Lodestar's argument was premised upon an improper dissection of the mark and a failure to consider the overall commercial impression created by Austin Nichols' WILD TURKEY mark.

Stichting Lodestar appealed the decision of the TTAB, and on January 10, 2007 — two days after oral argument in the matter — the U.S. Court of Appeals for the Federal Circuit unanimously affirmed the TTAB's decision without opinion. *Stichting Lodestar v. Austin, Nichols & Co.*, 214 Fed. Appx. 979 (Fed. Cir. 2007) (not published). A copy of the U.S. Court of Appeals' January 10, 2007 decision is attached hereto as Exhibit B. Stichting Lodestar did not take any further appeals, and the opposition proceeding was subsequently marked "terminated" by the TTAB on May 2, 2007.

In November 2003, months after Austin Nichols had filed an opposition to the application to register of WILD GEESE, Applicant applied to register WILD GEESE RARE IRISH WHISKEY, for the same goods (Application Ser. No. 79/000,112). In June 2004, the Trademark Examiner issued an Office Action initially refusing registration of WILD GEESE RARE IRISH WHISKEY based on a likelihood of confusion with the previously applied for WILD GEESE (which application, for all the Examiner could tell, had been filed by a different party). Applicant responded to the Office Action in December 2004, indicating that the applicant in the WILD GEESE application was a related party, and requesting suspension of the application to register WILD GEESE RARE IRISH WHISKEY in light of Austin Nichols' pending opposition to WILD GEESE. On December 14, 2004, further action on the WILD GEESE RARE IRISH WHISKEY application was suspended pending the outcome of the WILD GEESE opposition.¹

Due to a series of procedural errors, however, the WILD GEESE RARE IRISH WHISKEY mark was published for opposition on November 1, 2005. Thereafter, Austin Nichols instituted the instant opposition proceeding on November 28, 2005. As noted above, on January 17, 2006, the TTAB issued a decision sustaining Austin Nichols' opposition to the WILD GEESE application, finding that WILD GEESE was likely to be confused with Austin Nichols' WILD TURKEY marks (Ex. A). After the notice of appeal from that decision was filed, Applicant, on April 5, 2006, filed a motion to suspend the instant opposition pending the

¹ Notably, Applicant has also filed two additional applications, seeking to register THE WILD GEESE (Application Ser. No. 79/029,336) and THE WILD GEESE RARE IRISH WHISKEY (Application Ser. No. 79/029,337), respectively. These applications were filed on September 6, 2006, three years after the instant opposition proceeding was commenced, and six months after the TTAB sustained Austin Nichols' first opposition. The Trademark Examiner has issued Office Actions with respect to both applications, refusing to register the marks due to, among other things, the likelihood of confusion with Austin Nichols' WILD TURKEY marks. Applicant has not timely responded to the Office Actions. Further, Applicant has now filed a fifth application, seeking to register THE WILD GEESE SOLDIERS AND HEROES (Application Ser. No. 77/104,224). That application was filed on February 9, 2007 shortly after the Federal Circuit affirmed the decision of the TTAB sustaining Austin Nichols' opposition to the application to register WILD GEESE.

outcome of Austin Nichols' opposition to WILD GEESE. In its moving papers, Applicant stated:

The Opposer [Austin Nichols] in the related Opposition Proceeding [Opposition No. 91155615] is identical to the Opposer in this action. As noted above, the Applicant in the related Opposition Proceeding is related to the Applicant in this action. Likewise, the related Opposition Proceeding involves the same dispute (i.e., the right to register the mark WILD GEESE in light of the Opposer's WILD TURKEY trademark). . . . [T]he Board will ordinarily ". . . suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board."

On July 6, 2006, the TTAB issued a decision granting Applicant's motion to suspend the opposition to the application to register the WILD GEESE RARE IRISH WHISKEY mark, pending the outcome of the appeal of the TTAB's January 17, 2006 decision sustaining Austin Nichols' opposition to the application to register WILD GEESE. In issuing the July 6, 2006 decision, the TTAB agreed with Applicant that suspension was appropriate because the "disposition of Opposition No. 91155165 [Austin Nichols' opposition to the registration of WILD GEESE] may have a bearing" on the instant proceeding. *Id.*

ARGUMENT

I. THE TTAB SHOULD ENTER JUDGMENT AGAINST APPLICANT

Regardless of whether the Applicant responds to the September 7, 2007 order to show cause, the TTAB should enter judgment sustaining Austin Nichols' opposition to Applicant's application to register WILD GEESE RARE IRISH WHISKEY, in light of the Federal Circuit's January 7, 2007 decision affirming the TTAB's decision to sustain Austin Nichols' opposition to the application to register WILD GEESE.

Here, the TTAB issued a decision on January 17, 2006 sustaining Austin Nichols' opposition to Stichting Lodestar's (Applicant's "related company") application to register the WILD GEESE mark, finding that WILD GEESE was likely to be confused with Austin Nichols'

WILD TURKEY mark (Ex. A). Specifically, the TTAB determined that all of the relevant factors analyzed under the likelihood of confusion test, including the fame of the WILD TURKEY marks, the similarities between the parties' goods, trade channels, classes of purchasers for the goods, and between the WILD TURKEY and WILD GEESE marks themselves, weighed in Austin Nichols' favor. Applicant then conceded, in its motion to suspend the instant opposition that the TTAB's decision in the WILD GEESE opposition would be determinative of the instant opposition, which, according to Applicant's counsel, presents the exact same issues as the previously determined opposition, i.e., whether the mark WILD GEESE for various alcohol beverage products is likely to be confused with Austin Nichols' famous federally registered WILD TURKEY mark for various alcoholic beverage products.

Further, as the Examiner has already asked Applicant to disclaim the words RARE IRISH WHISKEY, and Applicant has agreed to do, so the instant opposition truly points to the same issues as the previously decided opposition. Since the TTAB has already made a determination of that very issue in Austin Nichols' favor, and for all the reasons set forth in its January 17, 2006 opinion, it should now sustain Austin Nichols' instant opposition to Applicant's application to register WILD GEESE RARE IRISH WHISKEY.

CONCLUSION

For the foregoing reasons, Austin Nichols requests that the TTAB sustain Austin Nichols' opposition to Applicant's application to register WILD GEESE RARE IRISH WHISKEY.

Dated: October 4, 2007

Respectfully submitted,

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AUSTIN NICHOLS & CO., INC. d/b/a

PERNOD RICARD U.S.A.

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X

Opposition No. 91167758

EXHIBIT A

H2006 WL 236409 (Trademark Tr. & App. Bd.)

*1 THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB
Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)
AUSTIN, NICHOLS & CO, INC.
v.
STICHTING LODESTAR

Opposition No. 91155165 to application Serial No. 76074330 filed on June 20, 2000

January 17, 2006
Oral Hearing: July 7, 2005

Louis S. Ederer of Torys LLP for Austin, Nichols & Co., Inc.
Gary J. Nelson of Christie, Parker & Hale, LLP for Stichting Lodestar

Before Hairston, Holtzman and Kuhlke
Administrative Trademark Judges
Opinion by Kuhlke
Administrative Trademark Judge:

Applicant, Stichting Lodestar (a Netherlands company), seeks registration of the mark WILD GEESE (in standard character form) for goods identified in the application as "beers, mineral and aerated waters; cola; soft drinks, namely, pop; lemonade; carbonated soft drinks; low calorie soft drinks; non-carbonated soft drinks; fruit drinks and fruit juices; syrups and preparations for making beers, mineral and aerated waters, cola, carbonated drinks, soft drinks, lemonade, carbonated soft drinks, low calorie soft drinks, non-carbonated soft drinks, fruit drinks and fruit juices" in International Class 32; and "alcoholic beverages, namely, wine, rum, gin, vodka, whiskey, alcoholic bitters, brandy, hard cider, distilled spirits, distilled liquor, alcoholic aperitif bitters, aperitif wines; aperitifs with a distilled alcoholic liquor base; aperitifs with a wine base; sake and prepared alcoholic cocktails" in International Class 33.^[FN1]

Opposer, Austin, Nichols & Co., Inc., opposed registration of applicant's mark, on the grounds that, as applied to applicant's goods, the mark so resembles opposer's previously used, registered and famous WILD TURKEY marks^[FN2] for various alcoholic beverages as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).^[FN3]

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

As a preliminary matter, we address two outstanding motions filed after the

briefing phase of this proceeding: opposer's motion (filed April 14, 2005) to accept opposer's late responses to applicant's requests for admissions; and opposer's motion (filed May 27, 2005) to reopen the record to introduce newly discovered evidence.

We construe opposer's motion to accept its responses to the requests for admissions as a motion to withdraw admissions under Fed. R. Civ. 36(b). Applicant served 25 requests for admissions on May 20, 2003. By its late responses, which were not served by opposer until October 24, 2003, opposer effectively admitted all of the requests including the following:

No. 14. Admit that none of the WILD TURKEY-based marks are used in association with whiskey.

No. 18. Admit that none of the WILD TURKEY-based marks are used in association with distilled spirits.

*2 No. 19. Admit that none of the WILD TURKEY-based marks are used in association with distilled liquor.

No. 25. Admit that none of the WILD TURKEY-based marks are used in association with prepared alcoholic cocktails.

Opposer states that it was not aware of the requests, served on May 20, 2003, until August 27, 2003 when, during a conversation with applicant, applicant indicated it had not received responses to the requests. Opposer states that upon further review of the case file, opposer discovered the requests stapled to the back of the interrogatories, and that on September 16, 2003, applicant wrote a letter concerning the requests for admissions. In this letter, applicant states that it "has been nearly one month since [applicant's counsel] had a telephone conference with one of [opposer's attorneys] regarding the above-identified WILD GEESE trademark opposition. During that telephone conference, I was informed that [opposer] would be promptly responding to Stichting Lodestar's First Request For Admissions, originally served on [opposer] on May 20, 2003. Please advise when we can expect to receive the responses." Opposer served its responses on October 24, 2003 concurrently with its responses to applicant's second set of interrogatories and requests for production of documents, due on that date.

In arguing against opposer's motion, applicant contends that opposer has not shown that its failure to serve timely responses was the result of excusable neglect, and that allowing withdrawal of the admissions at the conclusion of the trial would be prejudicial to applicant. In short, applicant would have the Board dispense with this case inasmuch as it has been admitted, by operation of the rules, that whiskey is not sold under the mark WILD TURKEY.

Fed. R. Civ. P. 36(b) provides that admissions may be withdrawn upon motion if "the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits."

Clearly, the presentation of the merits will be subserved by accepting the withdrawal of the four admissions. Moreover, applicant did not show that withdrawal of these four admissions will, in fact, prejudice it in presenting its defense on the merits. Applicant engaged in discovery on these very points, (see e.g., interrogatory no. 4 "Identify with particularity each product or service Opposer has sold or intends to sell under each of the WILD TURKEY-based marks,") presented evidence during trial, and argued its case on the merits. Moreover, it is difficult

to imagine how applicant could reasonably rely on an admission under these circumstances where opposer has several pleaded registrations for the mark WILD TURKEY for use with whiskey. Applicant did not seek to cancel these registrations by way of compulsory counterclaims, and opposer has submitted status and title copies of these registrations. Thus, opposer may rely on the presumptions accorded to these registrations, namely that it uses WILD TURKEY in connection with whiskey. In view thereof, opposer's motion to withdraw its admissions is granted and the denials to Request for Admissions Nos. 14, 18, 19 and 25 are accepted.

*3 By its motion to reopen the record, opposer seeks to introduce the decision from a court in New Zealand in a case involving these parties. Opposer argues that this decision serves as rebuttal evidence to applicant's arguments and evidence regarding trademark disputes between these parties involving their respective marks in other foreign jurisdictions, including Thailand. Inasmuch as applicant's arguments and evidence regarding foreign uses and trademark disputes are irrelevant to this proceeding, the rebuttal evidence is similarly irrelevant. Whether or not consumers in Thailand may or may not likely be confused under Thai trademark law is wholly irrelevant to whether or not there is a likelihood of confusion in the United States. Foreign use is ineffective to establish trademark rights in the United States and is thus irrelevant to a determination of likelihood of confusion here. See, Person's Co., Ltd. V. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) (foreign use has no effect on U.S. commerce and cannot form the basis for a holding that appellant has priority here; the concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme); Fruit of the Loom Inc. v. Fruit of the Earth Inc., 3 USPQ2d 1531, 1534 (TTAB 1987); and Lever Brothers Co. v Shaklee Corp., 214 USPQ 654, 657 (TTAB 1982). Cf. In re Bel Paese Sales Co., 1 USPQ2d 1233, 1235 (TTAB 1986) (foreign use is essentially of no probative value absent other evidence showing that the foreign use had a material or significant impact on perception of the term by the relevant purchasing public in the United States); and In re Men's International Professional Tennis Council, 1 USPQ2d 1917 (TTAB 1986). In view thereof, opposer's motion to reopen the record is denied.

Further, applicant has pointed out that opposer's main brief on the case was filed two days late on February 18, 2005. Trademark Rule 2.128(a)(1) states: "The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony." Notwithstanding that the rebuttal testimony period in this case closed on a Saturday (December 18, 2004), opposer's brief was due 60 days thereafter on February 16, 2004. Barring the granting of an extension of time by the Board, the plaintiff's main brief is due 60 days from the actual date on which the period for rebuttal testimony closes, regardless of whether that date falls on a weekend or a Federal Holiday. Opposer, in its mistaken belief that its brief was timely filed, misconstrues the effect of Trademark Rule 2.196 on the dates in question.^[FN4] Trademark Rule 2.196 extends the time period to take some action when that time period ends on a weekend or Federal Holiday; it does not then also automatically extend the date of subsequent dependent time periods unless those dates also end on a weekend or Federal Holiday. However, we note that this matter was raised merely as an informational statement in applicant's brief; that opposer's explanation as to its mistaken interpretation of the rules clearly demonstrates that the delay was not willful; that the two-day delay in filing opposer's brief was minimal and has had no impact on the proceedings; and that applicant has indicated no prejudice as a result of the delay. Under the circumstances, and because it benefits the Board in its ability to make a just determination of the case to have the briefs of both parties of record,

opposer's brief is accepted.

*4 Finally, before we turn to the merits of this proceeding, we address those of applicant's objections to exhibits introduced during testimony that were maintained in applicant's brief. Applicant objects to opposer's exhibits nos. 11, 14, 43, 48, 49 and 50. Applicant argues that these exhibits "should be excluded because they were not produced in a timely manner." Applicant's Br. p. 16. Applicant did not indicate in its brief whether or not it had requested these documents during discovery, nor did applicant include a copy of any request for production of documents. Applicant did, however, submit under notice of reliance, opposer's responses to applicant's first set of interrogatories, and opposer, in response to some of the objections, states that it produced related documents; therefore, where possible, we will address these objections on the merits.

Opposer, in response, argues as to exhibit nos. 11, 14 and 43 that "they relate to business activities after January 2004 (and were created after the January 31, 2004 [discovery] cut-off date) and were produced to update information of the same nature that had already been produced during discovery." Opposer's Br. p. 17. With regard to exhibits 49 and 50, opposer requests that the Board take judicial notice of these exhibits, inasmuch as they are official records of the USPTO.

Applicant's objection to exhibit nos. 11 and 14 are overruled. Exhibit no. 11 is opposer's most recently prepared "block chart." This "block chart," showing the budget plan for media spending in 2004 on a monthly basis, was prepared by opposer's media agency on August 1, 2004, one month before it was produced, and the day before opposer's testimony deposition. Exhibit no. 14 is a series of print advertisements from 2004. Applicant has not presented argument as to how it would be prejudiced by the submission of this recent, updated information, nor did applicant indicate that no documents as to media spending or print advertisements had been produced and, in fact, the record contains such undisputed documents. Thus, we find opposer's explanation that it had produced such documents and that these merely represent the most recent, updated information sufficient to overcome the objection.

Applicant's objection to exhibit no. 43 is sustained. Interrogatory no. 9 reads: "Identify each person who is or has ever been licensed or permitted by you to use any of the WILD TURKEY-based Marks, and explain how you control the nature and quality of each such use." Opposer responded: "None at the present time." Exhibit no. 43 is a licensing agreement between opposer and a third-party entered into in May, 2004. While there is nothing in the record to show that applicant requested the production of any licensing agreements, applicant's interrogatory requested essentially the same information and opposer should have supplemented its response to the interrogatory, in a more timely manner, by providing the name of the licensee prior to September 2, 2004, and the licensing agreement in exhibit no. 43 is tied to the testimony regarding opposer's licensee.

*5 Applicant's objection to exhibit no. 48 on the ground that it was not timely produced is overruled. This exhibit is a printout of a third-party website that was retrieved and printed out by opposer's attorney the day before opposer's testimony deposition. Applicant did not indicate if it had requested this type of information during discovery and in any event opposer was not obligated to disclose the entirety of its proposed evidence. British Seagull Ltd. V. Brunswick Corp., 28 USPQ2d 1197, 1201 (TTAB 1993, aff'd, Brunswick Corp. v. British Seagull Ltd., 35

F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); and Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1657 (TTAB 2002). That being said, the witness attesting to this evidence did not have personal knowledge of the source of the printout and, therefore, was not competent to testify as to its authenticity. Thus, the document is not admissible.

Applicant's objection to exhibit no. 49 is overruled. This exhibit consists of the USPTO Trademark Electronic Search System (TESS) printouts of opposer's pleaded registrations, the status and title copies of which were also submitted under notice of reliance.

Applicant's objection to exhibit no. 50 is overruled. This exhibit consists of printouts of two of opposer's applications that were not pleaded. Applicant has not shown the Board that it requested information or documents pertaining to these marks.^[FN5]

The evidence of record consists of the pleadings herein; the file of the opposed application; the testimony depositions (with exhibits, excluding exhibits nos. 43 and 48) of Mr. Joseph Uranga, Group Director for Wild Turkey Bourbon with Pernod Ricard USA, and Mr. John Conway, in house intellectual property counsel with Pernod Ricard USA.^[FN6] In addition, opposer submitted, under a notice of reliance, status and title copies of five of opposer's pleaded registrations, and testified as to their ownership and validity.^[FN7] Applicant submitted, by stipulation of the parties, the declaration (with exhibits) of Deanna D. Crowe, a paralegal with applicant's outside counsel, Christie, Parker & Hale, LLP. In addition, applicant submitted, under a notice of reliance, TESS printouts of third-party registrations, foreign registrations for the parties' respective trademarks, and opposer's responses to applicant's interrogatories.

The pleaded registrations, all of which are in full force and effect and owned by opposer, are summarized as follows:

Registration No. 513549 for the mark

**WILD
TURKEY**

for whiskey in International Class 33, filed January 30, 1946, issued August 16, 1949, section 8 accepted, section 15 acknowledged, renewed; Registration No. 1085002 for the mark WILD TURKEY (in standard character form) for liqueur in International Class 33, filed November 22, 1976, issued February 7, 1978, section 8 accepted, section 15 acknowledged, renewed;
*6 Registration No. 1299830 for the mark



(WILD TURKEY ONE-O-ONE and turkey design, ONE-O-ONE disclaimed)

for whiskey in International Class 33, filed October 19, 1983, issued October 19, 1984, section 8 accepted, section 15 acknowledged, renewed; Registration No. 1670450 for the mark



(WILD TURKEY KENTUCKY LEGEND BEYOND DUPLICATION and design) for distilled alcoholic beverages; namely, whiskey in International Class 33, section 8 accepted, section 15 acknowledged, renewed; Registration No. 2263231 for the mark WILD TURKEY (in standard character form) for whiskey in International Class 33, filed August 14, 1998, issued July 20, 1999, section 8 accepted, section 15 acknowledged.

Because opposer has made its five pleaded registrations of record, opposer has established its standing to oppose registration of applicant's mark, and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Another key factor, is the fame of the prior mark. We begin with this factor, because fame "plays a 'dominant' role in the process of balancing the du Pont factors." Recot Inc. v. Benton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, Palm Bay Imports, Inc. v. Veuve Clicquot, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In addition, fame "varies along a spectrum from very strong to very weak." In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003).

Opposer's testimony and evidence establish that opposer started selling its whiskey under the WILD TURKEY trademark in 1942; that sales of WILD TURKEY products in the United States in 2002 and 2003 were approximately \$65 million and 500,000 cases in total annual sales; that the WILD TURKEY trademarks have been federally registered since 1949; that opposer owns registrations for WILD TURKEY marks in connection with various merchandise, including umbrellas, duffel bags, clothing, watches, pens and pencils, golf accessories, key chains, and barbecue sauce; that opposer spends tens of millions of dollars annually on advertising and promotion in the United States, \$11.7 million in 2003, through print ads in national magazines and trade

publications, billboard advertising, local radio advertising, and internet advertising; that opposer has a "comprehensive brand strategy program" that educates employees, distributors and retailers about the history of WILD TURKEY, brand identity, and the objectives and strategy for promoting and selling the brand that includes a "field guide" and the "ambassador's training program"; that WILD TURKEY is used on consumer point-of-sale materials given or displayed to consumers at liquor stores, bars and restaurants and include baseball hats, golf shirts, golf bags, watches, scratch card games, cufflinks, flashlights, computer mouse pads, ceramic collectibles, promotional cookbooks with WILD TURKEY recipes; that opposer also promotes its WILD TURKEY whiskey through high profile national sponsorships such as the Professional Bowler's Association and the National Turkey Federation and numerous local sponsorships such as a crawfish festival in Biloxi, Mississippi and a rodeo in Houston, Texas; and that the WILD TURKEY brand receives extensive unsolicited media coverage including reviews by wine and spirit writers, numerous awards such as Gold and Silver places in the International Wine & Spirit Competition and San Francisco World Spirits Competition in 2000 and 2001, frequent mentions in a variety of magazines, newspapers, and television shows (see, e.g., *Uranga Dep.* p. 78 "The biggest one was when David Letterman had [the turkey callers] on.... [T]he bottle spent about 20 minutes on his desk as he talked about the callers..."). In addition, the record shows that opposer, as part of the Pernod Ricard Group, jointly promotes its WILD TURKEY whiskey with other Pernod Ricard Group brands (e.g., Bushmill's Irish whiskey), and opposer has expanded its WILD TURKEY whiskey product to include other premium bourbon and non-bourbon whiskeys and other spirit products.

*7 Applicant presented no evidence or argument to rebut opposer's evidence of fame.

As shown through the testimony and other evidence, opposer has extensive sales under and advertising expenditures in connection with the WILD TURKEY marks. Moreover, opposer's advertising and sales statistics are placed in the context of a broad, organized and aggressive marketing strategy that places its WILD TURKEY marks in front of consumers in a variety of ways (e.g., point-of sales displays, promotional events, sponsorships, merchandising, radio advertising, national magazines with wide circulation, billboards, etc.). The WILD TURKEY marks have been used for over sixty years and are displayed prominently on the product labels. WILD TURKEY whiskey has been extensively promoted and heavily advertised in a variety of media. There has also been promotion through targeted outdoor billboard displays, extensive point-of-sale displays, and wide distribution of collateral merchandise. On this record, we find that opposer's WILD TURKEY marks are famous and entitled to broad protection. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) ("[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.").

We turn next to the second, third and fourth du Pont factors, i.e., the similarities between opposer's and applicant's goods and the similarities between opposer's and applicant's trade channels and classes of purchasers of these goods. We must make our determinations under these factors based on the goods as they are recited in the application and registrations, respectively. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The goods need not be identical or directly competitive in order for there to be a

likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Opposer's registrations are for whiskey and liqueur. Whiskey, as identified in applicant's application, is identical to whiskey, as identified in opposer's Registration Nos. 513549, 1299830, 1670450 and 2263231, and closely related to opposer's liqueur as identified in opposer's Registration No. 1085002. In addition, beer in International Class 32 and the other alcoholic beverages in International Class 33 as identified in applicant's application are closely related to opposer's whiskey and liqueur. The record shows that consumers of alcoholic beverages are accustomed to seeing brands on new products, including the crossover from distilled spirits to malt beverages. Conway Rebuttal Dep. p. 12. Applicant has presented no argument that its beer and other alcoholic beverages are unrelated to opposer's goods and, moreover, has acknowledged that various alcoholic beverages, including beer, are related. (Applicant's Br. p. 34 "[A]lcoholic beverages such as wine and beer, and the various types of 'hard liquors' such as whiskey, have been consistently recognized as related goods for trademark purposes.").^[FN8]

*8 Given the absence of any restrictions or limitations in the parties' respective identifications of goods, the parties' identical and closely related alcoholic beverage products are deemed to be marketed in the same trade channels and to the same classes of purchasers. Kangol Ltd. V. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). In addition, the record establishes that sales of alcoholic beverages in the United States are regulated by the Alcohol, Tobacco and Trade Bureau which imposes a three-tier system of distribution whereby suppliers (such as opposer) sell to distributors who, in turn, sell to retailers and the end-consumers purchase the products from the retailers. Thus, the parties' alcoholic beverages, in fact, travel through the same channels of trade.

The parties' respective goods are ordinary consumer items which would be purchased without a great deal of care, by ordinary consumers. (Conway Dep. p. 31 lines 21-22 ("Our consumers are not sophisticated") and Conway Rebuttal Dep. p. 9 ("... we are an impulse item"). See also, e.g., In re Majestic, supra at 1205. Applicant points to opposer's testimony regarding brand loyalty and argues that brand conscious consumers would distinguish between the marks; however, there is no evidence that ordinary consumers of alcoholic beverages are always brand conscious. These findings under the second, third and fourth du Pont factors all weigh significantly in opposer's favor in our likelihood of confusion analysis.

We turn next to the first du Pont factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). Furthermore, if a mark comprises both a word and a

design, greater weight is often accorded to the word, which would be used by purchasers in requesting the goods or services. In re Appetito Provisions Co., Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

Applicant's mark, WILD GEESE, is depicted in standard character form. Two of opposer's WILD TURKEY marks are in standard character form and the other three are stylized, two of which include design elements and additional wording. The literal portions of the parties' marks begin with the identical word, WILD. The similarity of the marks continues with the second word in each mark being a game bird. Despite the difference in the words TURKEY and GEESE, the commercial impression and general connotation of wild game birds, creates a confusingly similar mark. Given the fame and arbitrary nature of opposer's WILD TURKEY marks, and the broad scope of protection to which they are entitled, we find that the similarities in the parties' marks outweigh their differences.

*9 Similarity of connotation or commercial impression alone is sufficient to support a finding of likelihood of confusion between marks; and this is true even if the marks exhibit aural and optical dissimilarity when they convey the same general idea or stimulate the same mental reaction. H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 USPQ 62, 65 (TTAB 1979) (hereinafter Sohne I); and H. Sichel Sohne, GmbH v. John Gross & Co., 204 USPQ 257 (TTAB 1979) (hereinafter Sohne II) (BLUE NUN and BLUE CHAPEL bring to mind a similar religious connotation). This is true especially where, as in this case, the marks are arbitrary. United Rum Merchants Ltd. v. Fregal, Inc., 216 USPQ 217, 219 (TTAB 1982).

In arguing that the marks are dissimilar, applicant dissects registrant's marks and concludes that the common term WILD is weak, in view of the numerous third-party registrations and uses of the word WILD in connection with various alcoholic and non-alcoholic beverages, and that the word TURKEY is the dominant portion of registrant's mark, which is different from the word GEESE in applicant's mark. Applicant further argues that the word TURKEY should be accorded narrow protection in view of the numerous registrations and uses of bird names in connection with various alcoholic and non-alcoholic beverages.

First, with regard to the evidence pertaining to the word WILD, the third-party registrations are not evidence of use and, thus, are of little probative value in an analysis of the strength of the marks. Third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or industry and that said term has less than arbitrary significance with respect to certain goods or services." In re Dayco Products-Eaglemotive, Inc., 9 USPQ2d 1910, 1912, (TTAB 1988) (IMPERIAL adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation). However, the third-party registrations submitted by applicant show a variety of meanings of the term WILD (e.g., WILD PIG, DR. WILD, WILDCATTER'S CRUDE, WILD RIVER, WILD CARD and SCREAMING WILD BERRY) and do not lead to a conclusion that the term has an "ordinary significance" in the field of beverages. The examples of use also suffer from the same deficiency (e.g., THE WILD BUNCH, WILD THING, WILD PASSION and WILDCAT). Moreover applicant's argument does not rebut the facts of this case where the word WILD has a specific significance as used with TURKEY or GEESE in that it distinguishes the birds from their domesticated relatives.

The third-party registrations and examples of use of bird names for various beverages have even less probative value under the Dayco analysis inasmuch as they present a variety of names, do not point to ordinary usage of a particular term, and do not show that the words in issue here, TURKEY and GEESE are so widely used that consumers are able "to discern between several competing products having similar, but not identical, product names and bird images." Applicant's Br. p. 33. See *Sohne I*, supra at 66 ("We must remember that the conflict herein is between "BLUE ANGEL" and "BLUE NUN," and the fact that others have used and/or registered marks containing a certain feature in common with these marks for similar goods cannot preclude a holding that these marks as a whole are confusingly similar.")

*10 Applicant, in its analysis, improperly dissects the marks and does not consider the marks in their entirety. We note that despite applicant's search of USPTO records and the marketplace, applicant failed to find any example of WILD plus a game bird in use in the United States for any of the identified goods.^[FN9] See Crowe Decl. and Applicant's Notice of Reliance; see also *Uranga Dep.* p. 39 and *Conway Dep.* p. 22. This may in fact be a result of opposer's policing efforts. See *Conway Dep.* p. 22 ("But the closer it gets to a bird the more serious we take it. And if it's a game bird in particular that is one of our absolute red flags for enforcement.")^[FN10]

As stated earlier, marks must be considered in their entirety, and the commercial impression is derived from the marks as a whole, and not from their elements separated and considered in detail. *Sohne I*, supra at 65. We find that the WILD TURKEY portion of opposer's registered marks is unitary and that TURKEY cannot be viewed as a separable element of the marks. The handful of examples of use in the record of TURKEY as a "nickname" for the brand are not sufficient to diminish the unity of the WILD TURKEY marks in issue here. However, even if TURKEY is the dominant part of the mark, it does not change our conclusion that taken in their entirety and given the strength and fame of opposer's WILD TURKEY marks, confusion is likely. We consider the similarity of these marks where the word WILD is followed by the name of a game bird to be significant. We find, on balance, that the similarities in connotation and commercial impression of the respective marks which are enhanced by the identical first word, WILD, followed by the name of a game bird outweigh the dissimilarities which result from the sound and appearance of the second word. Further, the stylization in Registration No. 513549, the stylization, bird design and disclaimed wording ONE O ONE in Registration No. 1299830, and the added tag line KENTUCKY LEGEND BEYOND DUPLICATION and frame design in Registration No. 1670450 do not serve to adequately distinguish these marks. The term WILD TURKEY is the dominant element in each of these marks and the bird design further enhances the mental impression and connotation of a game bird. We conclude that the parties' marks are substantially similar.

We do not find applicant's attempt to distinguish the United Rum and *Sohne* cases persuasive. In particular, with regard to the *Sohne* cases, the Board emphasized that it considered the marks BLUE NUN on the one hand, and BLUE ANGEL and BLUE CHAPEL on the other, in their entirety and rejected the applicant's similar attempt to minimize the importance of the identical element BLUE.

Considering the respective marks in their entirety, we conclude that the evidence of record as it pertains to the relevant *du Pont* factors clearly supports a finding of likelihood of confusion as to the marks in opposer's Registrations Nos. 513549, 1085002, 1299830, 1670450, and 2263231 and that registration of applicant's mark,

therefore, is barred under Trademark Act Section 2(d).

*11 Finally, to the extent there is any doubt with regard to the question of likelihood of confusion, such doubt must be resolved in favor of opposer, the prior registrant. *Hewlett-Packard Co. v. Packard Press, inc.*, 281 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks"); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The opposition is sustained.

FN1. Serial No. 76074330, filed June 6, 2000. The application is based on a foreign application under Trademark Act Section 44(d), 15 U.S.C. §1126. The bona fide intent-to-use basis under Trademark Act Section 1(b), 15 U.S.C. §1051(b), was deleted during prosecution.

FN2. Opposer pleaded six registrations which are discussed infra.

FN3. The notice of opposition also references a claim of false suggestion of a connection under Section 2(a) of the Trademark Act and dilution under Section 43(c) of the Trademark Act; however these claims were not sufficiently pleaded and opposer did not pursue these claims in its brief or at oral hearing. In view thereof, the Board considers the false suggestion and dilution claims to have been waived.

FN4. Opposer states that it "confirmed its analysis, and the February 18, 2005 filing deadline, by telephone with the Board." Opposer's Reply Br. p. 18. Opposer is advised that parties may not rely on information obtained by telephone. Trademark Rule 2.191 provides in pertinent part: "The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulations, or understanding in relation to which there is disagreement or doubt." See *In re Merck & Co.*, 24 USPQ2d 1317, 1318 n. 2 (Comm'r 1992).

FN5. We note that applicant did not object on the basis that the applications were not pleaded.

FN6. Pernot Ricard USA is a related company to opposer and handles opposer's sales, marketing and intellectual property matters. (Uranga Dep. p. 7; Conway Dep. pp. 5-9).

FN7. Opposer did not make of record pleaded registration no. 1912713.

FN8. See also, for example, *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (beer and tequila closely related; *Jose Gaspar Gold v. Gaspar's Ale*); *In re Majestic*, supra (brewed malt liquor and distilled tequila similar "by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers"); *The Fleischmann Distilling Corporation et al. v. Maier Brewing Co. et al.*, 314 F.2d 149, 160, 136 USPQ 508, 518 (9th Cir. 1963) (beer and whiskey "being both within the alcoholic beverage industry, are 'so related as to fall within the mischief which

equity should prevent.''); White Horse Distillers, Ltd. V. Ebling Brewing Co., Inc., 30 USPQ 238 (CCPA 1936) (scotch whiskey and ale are "goods of the same descriptive properties within the meaning of the statute"); Somerset Distilling Inc. v. Speymalt Whiskey Distributors Ltd., 14 USPQ2d 1539, 1542 (TTAB 1989) ("scotch whiskey, gin and vodka are all closely related, in that they are what might be characterized as basic alcoholic beverages"); and In re AGE Bodegas Unidas, S.A., 192 USPQ 326 (TTAB 1976) ("there is clearly a relationship between wine and whiskey, both of which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time").

FN9. With regard to the two examples of WILD with a bird allegedly used in connection with wine that appear in printouts of website pages introduced under the Crowe declaration, opposer's undisputed evidence shows that neither of those products are being sold in the United States, and that one is in the process of being acquired by opposer. Conway Rebuttal Dep. pp. 59-60, 67-73.

FN10. Applicant's arguments regarding opposer's "aggressive enforcement program" have no relevance to the question of whether applicant's mark used in connection with the goods recited in its application would be likely to cause confusion with the marks in opposer's registrations.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT AND TRADEMARK TRIAL AND APPEAL BOARD

Mark: WILD GEESE RARE IRISH WHISKEY

Serial No. 79/000,112

Filed: November 19, 2003

Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a
PERNOD RICARD U.S.A.,

Opposer,

v.

LODESTAR ANSTALT,

Applicant.

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x

Opposition No. 91167758

EXHIBIT B

■ Stichting Lodestar v. Austin Nichols & Co., Inc.
C.A.Fed., 2007.

This case was not selected for publication in the
Federal Reporter. Not for Publication in West's
Federal Reporter. See Fed. Rule of Appellate
Procedure 32.1 generally governing citation of
judicial decisions issued on or after Jan. 1, 2007. See
also Federal Circuit Rule 32.1 and Federal Circuit
Local Rule 32.1. (Find CTAF Rule 32.1)

United States Court of Appeals, Federal Circuit.

STICHTING LODESTAR, Appellant,

v.

AUSTIN NICHOLS & CO., INC., Appellee.

No. 2006-1388.

Jan. 10, 2007.

On Appeal from the United States Patent and
Trademark Office, Trademark Trial and Appeal
Board, Opposition No. 91/155, 165.

Before MICHEL, Chief Judge, SCHALL, and
PROST, Circuit Judges.

Judgment

PER CURIAM:

*1 This CAUSE having been heard and considered, it
is ORDERED and ADJUDGED:

AFFIRMED. See Fed. Cir. R. 36.

C.A.Fed., 2007.

Stichting Lodestar v. Austin Nichols & Co., Inc.

214 Fed.Appx. 979, 2007 WL 200930 (C.A.Fed.)

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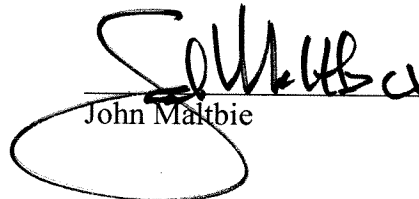
CERTIFICATE OF SERVICE

I certify that on October 4, 2007, the foregoing **OPPOSER'S STATEMENT IN SUPPORT OF THE ENTRY OF JUDGMENT AGAINST APPLICANT** is being electronically filed with the following:

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

It is further certified that on October 4, 2007, the foregoing **OPPOSER'S STATEMENT IN SUPPORT OF THE ENTRY OF JUDGMENT AGAINST APPLICANT** is being served by mailing a copy thereof by first class mail addressed to:

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John Maltbie